

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

MAILED

APR 24 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID K. McKNIGHT and EDUARDUS A.T. MERKS

Application 09/489,793

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on March 31, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

An Examiner's Answer was mailed on September 22, 2005. However, the appeal conference is improper. Section 1208 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., August 2001) states:

APPEAL CONFERENCE

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § 1206) has been filed. . . .

. . . .

. . . . If the examiner's answer does not contain the appropriate a indication that an appeal conference has been held (i.e., including the names of the conferees and identifying themselves as the conferees along with their initials), the Board should return the application directly to the appropriate Technology Center (TC) Director for corrective action. . . . This procedure applies to all examiner's answers received by the Board on or after November 1, 2000.

The Examiner's Answer mailed on September 22, 2005, is deficient in that there is no evidence that an appeals conference has been held.

Accordingly, it is ORDERED that the application is return to the Examiner:

- 1) to vacate the Examiner's Answer mailed September 22, 2005, and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004 with the appropriate notation of an appeal conference; and
- 2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCE



DALE M. SHAW
Program and Resource Administrator
(571) 272-9797

DMS/pgc

cc: IBM Corporation
3039 Cornwallis Rd.
Dept. T81/B503, P.O.Box 12195
Reasearch Triangle Park, NC 27709